

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
Reply to Office Action of Aug. 12, 2003

REMARKS/ARGUMENTS

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application is anticipated under the provisions of 35 USC § 102 or obvious under the provisions of 35 USC § 103. Furthermore, the Applicants also submits that all of these claims now satisfy the requirements of 35 USC § 112. Thus, the Applicants believe that all of these claims are now in allowable form.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, the Examiner should telephone Mr. Peter L. Michaelson, Esq. at (732) 530-6671 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Rejections

A. Rejections under 35 USC § 112

The Examiner has rejected claims 2-33 as being indefinite under the provisions of the second paragraph of 35 USC § 112.

Specifically, the Examiner noted that the verbal phrase "can be executed" appearing in independent claims 2 and 18 is indefinite inasmuch as it is "unclear whether or not the execution is required to meet the claimed invention".

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
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In response, the Applicants have now changed the verb "can be" to "is" in order to clearly recite that such execution is required to meet the claimed invention, hence providing a positive and definite limitation.

Accordingly, the Applicants submit that claims 2-33, as now amended, are sufficiently definite under the provisions of 35 USC § 112 and are patentable thereunder.

B. Rejections under 35 USC § 102(e)

The Examiner has rejected claims 2-4 and 18-20 under the provisions of 35 USC § 102(e) as being anticipated by the teachings of the Himmel et al patent (United States patent 6,275,854 issued to M. A. Himmel et al on August 14, 2001). This rejection is respectively traversed for two distinct reasons: (a) this reference does not constitute prior art under 35 USC § 102(e) against the present application, and (b) assuming arguendo, the reference does qualify as prior art, its teachings do not anticipate these claims.

1. The Himmel et al patent is not prior art under 35 USC § 102(e)

Section 102 states, in pertinent part:

"A person shall be entitled to a patent unless:
... (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent"
[emphasis added]

As the language of this section clearly mandates, a reference is prior art under § 102(e) only if the invention was described in patent by another which was filed BEFORE the invention thereof by the applicant for patent.

The filing date of the Himmel et al patent is May 15, 1998. The present application is a divisional of a continuation-in-part of a parent application (serial number: 09/080,165, now abandoned), with the parent application having been filed on the same exact day as that of the Himmel et al patent: May 15, 1998.

A review of the Applicants' 09/080,165 parent application reveals that the subject matter recited in independent and parallel claims 2 and 18 (from which claims 3 and 4, and 19 and 20 respectively depend) is fully described in the parent application, with illustrative specific page and line references as noted in the following table

Claim 2 elements	Illustrative corresponding sections of 09/080,165 application
Apparatus for a network server, for use in distributing an information object to a client computer, comprising: a processor; and a memory connected to the processor and storing computer executable instructions; and wherein the processor, in response to the instructions: receives a request from the client computer	Page 3, lines 12-16; Page 4, lines 6-11; and Claim 1.

to download to the client computer an agent for rendering an information object,	Page 3, lines 12-16 and 21-27; Page 19, lines 17-22 and 24-26; and Claim 1.
the request being issued by the client computer in response to execution, through a browser situated and executing in the client computer, of advertising code embedded in a web page to be displayed by the browser; and	Page 3, lines 12-16; and Claim 1.
downloads, in response to the request, the agent to the client computer	Page 12, lines 4-6; Page 19, lines 16-22; and Claim 1.
such that the agent is executed, under the browser, in the client computer	Page 3, lines 21-27; and Claim 1.
for subsequently rendering the information object.	Page 3, lines 7-11; Page 55, lines 1-5; and Claim 1.

Claim 18 has substantially parallel recitations to those set forth above for claim 2.

The date of the Applicants' invention predates its May 15, 1998 priority date (which, as noted in the Applicants' declaration, has been claimed under 35 USC § 120). Nevertheless, assuming arguendo and under a worst case scenario that the date of invention was May 15, 1998, the Himmel et al patent does not qualify as prior art against the present application under 35 USC 102(e) inasmuch as the filing date of this reference is not before the Applicants' May 15, 1998 invention date. The express language of this section does not permit these dates to be the same, but rather requires the effective date of the reference to precede the date of invention. Here, the former does not precede the latter.

As such, the Himmel et al patent does not qualify as prior art against the present application and hence must be removed as such.

2. The Himmel et al patent does not anticipate claims 2-4 and 18-20

Alternatively, should the Examiner disagree with the Applicants' view and maintain his contention that the Himmel et al patent constitutes valid prior art, the Applicants submit that the teachings of this patent do not anticipate claims 2-4 and 18-20. Inasmuch as independent claims 2 and 18 are parallel apparatus and method claims, then, for simplicity, the Applicants will focus their ensuing comments on claim 2.

Specifically, the Examiner believes that each recitation of claim 2 is identically disclosed in the Himmel et al patent. As the Examiner will soon appreciate, this is not so.

The Himmel et al patent describes apparatus and an accompanying method for determining an amount of time a user spends in actually viewing, though his(her) browser, an advertisement depicted on a web page.

In particular and as described in col. 8, line 17 et esq. of this patent and with reference to FIG. 6 thereof, a web page is downloaded into a client browser and contains advertising elements, illustratively A-D, with each element representing an image and/or text for displaying an advertisement to a user. As explicitly stated in col. 8,

line 21 et esq., during downloading each page, a JAVA applet, specifically advertisement control module 604, is also downloaded and is responsible for displaying the web page and its contents, and detecting when an advertisement is viewable. For each advertisement element, module 604 invokes a corresponding JAVA script (shown here as A'-D' for elements A-D, respectively) to record time, in pre-selected intervals, during which the associated advertisement was visible. All of these scripts are substantially similar to each other and are downloaded along with module 604.

As described in col. 8, line 55 et esq., as each advertisement A-D becomes viewable (i.e., completely or identifiably seen by a user, though not necessarily completely seen), advertisement control module 604 detects this visibility and begins to time it. If that time during which the advertisement is viewable exceeds a pre-selected interval, then control module 604 invokes the corresponding JAVA Script, e.g., script A'. If the client computer is connected to the Internet, then script A' transmits that time to a corresponding server. Alternatively, if the client computer is not connected to the Internet, then the script records and locally stores the time, along with a URL of the page being viewed, in a corresponding cookie. When that user later re-connects to the Internet and requests a web page, the cookie is retrieved and transmitted to the server.

The Applicants' inventive technique used in implementing a network server for delivering Internet advertising, generally speaking information objects,

drastically differs from the advertisement timing technique taught by the Himmel et al patent.

In sharp contrast to the teachings in the Himmel et al patent, the Applicants technique, as described on page 22, line 14 et esq. of the present specification, relies on embedding advertising code (specifically an "advertisement tag") within each of a number of different web pages ("referring web pages") stored on one or more remote network web servers. The advertising tag is very compact and contains two components: one component for downloading a script from a specified distribution server, and the other component being a network address of an information management server (e.g., an advertising management server).

During the course of browsing the web, a user may select and download to his(her) client browser a web page that contains such a tag. As that web page is downloaded, the browser interprets and processes the coding of that page, including the embedded advertising tag itself.

Once the tag is processed, the client browser downloads a script from its corresponding distribution server, which, in turn when executed, downloads and instantiates an agent. Note that the agent is not downloaded along with the page but is ultimately downloaded in response to browser execution of the tag. The agent itself, once executing under the browser, controls subsequent download of the information object and its rendering.

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
Reply to Office Action of Aug. 12, 2003

Given the above, a fundamental distinction exists between the express teachings in the Himmel et al patent and the inventive technique, as recited in claim 2. Specifically, the Himmel et al patent teaches that the JAVA applet, i.e., the advertisement control module (604), and its accompanying JAVA Scripts (A'-D') are all downloaded together with the requested web page. In that regard, col. 8, lines 20-22 state:

"During the downloading of web page 194 [erroneously shown in FIG. 6 as 94], a Java Applet (Advertisement Control Module 604) is also downloaded and executed."

and lines 33-36 of the same column state:

"In addition to downloading the Advertisement Control Module 604, a corresponding non-visible JavaScript A'-D' 704-710 [reference FIG. 7] is also downloaded for each one of the advertisements A-D 606-612, respectively."

In stark contrast to the express teachings of the Himmel et al patent, the Applicants' agent is downloaded only after an advertisement tag contained in a referring web page is executed. The agent is not simply downloaded directly with the page.

Further and specifically, the Applicants' agent is downloaded in response to a request issued by the client browser which results from browser execution of the advertisement tag embedded within the referring page. The Himmel et al patent does not teach the use of any such request for a good reason: it is unnecessary as the JAVA applet and the individual JavaScripts taught by the Himmel

et al patent are all directly downloaded along with the associated web page and not as a result of that page or any tag in it being executed by a client browser. Moreover, the Himmel et al patent contains no teachings whatsoever, express or implied, of embedding any tag within a page to control download and rendering of an advertisement -- as the Applicants teach.

Independent claim 2 contains suitable limitations directed to the distinguishing aspects of the Applicants' present inventive apparatus. In that regard, this claim states as follows with those recitations being shown in a bolded typeface:

"Apparatus for a network server, for use in distributing an information object to a client computer, comprising:
a processor; and
a memory connected to the processor and storing computer executable instructions; and
wherein the processor, in response to the instructions:
receives a request from the client computer to download to the client computer an agent for rendering an information object, the request being issued by the client computer in response to execution, through a browser situated and executing in the client computer, of advertising code embedded in a web page to be displayed by the browser; and
downloads, in response to the request, the agent to the client computer such that the agent is executed, under the browser, in the client computer for subsequently rendering the information object." [emphasis added]

Independent method claim 18 is parallel to claim 2 and hence contains very similar distinguishing limitations.

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
Reply to Office Action of Aug. 12, 2003

Hence, the Applicants submit that neither independent claim 2 nor claim 18 is anticipated by the teachings in the Himmel et al patent. As such and should the Examiner persist in his view that the Himmel et al patent constitutes prior art, both of these independent claims are patentable under the provisions of 35 USC § 102(e) over the teachings of this patent.

Each of claims 3-4 and 19-20 depends, either directly or indirectly, from claims 2 and 18, respectively, and recites further distinguishing features of the present invention. Accordingly and again if the Himmel et al patent is viewed as prior art, each of these dependent claims is also patentable under the provisions of 35 USC § 102(e) over the teachings of that patent for the exact same reasons set forth above.

C. Rejections under 35 USC § 103

The Examiner has rejected dependent claims 10-12 and 26-28 under the provisions of 35 USC § 103 as being obvious over the teachings in the Himmel et al patent. This rejection is respectively traversed for two reasons:

- (a) this reference does not constitute prior art under 35 USC § 103 against the present application, and
- (b) assuming arguendo, the reference does qualify as prior art, its teachings do not render these dependent claims obvious.

1. The Himmel et al patent is not prior art under 35 USC § 103

As discussed above, the May 15, 1998 filing date of the Himmel et al patent does not precede both the filing date, and under a worst case view, the Applicants' date of invention. Hence, as is the case for 35 USC § 102(e), the Himmel et al patent is not prior art under 35 USC § 103 either and hence must be removed as such.

2. The Himmel et al patent does not anticipate dependent claims 10-12 and 26-28

Claims 10 and 11 (and 26 and 27) respectively recite that the Applicants' agent comprises first and second applets, and that these applets specifically comprise Transition Sensor and an AdController applets. Claim 12 and 28) recites that the advertising code specifies a network server on which the agent resides with that server being a distribution server.

The teachings in the Himmel et al patent so diverge from those of the present Applicants, particularly with respect to their invention recited in independent claim 2, that any person of ordinary skill in the art, when faced with the problem set forth in that patent, would not be motivated to think in the inventive direction taught by the Applicants.

In that regard, this patent teaches a solution to rendering and timing the display of Internet advertisements by downloading to a client computer, directly with a web page, appropriate modules (specifically advertisement

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
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control module 604, which is a JAVA applet, and individual Java Scripts) that accomplish these tasks.

Doing so carries a significant drawback -- one which the present Applicants intentionally and advantageously solve.

In particular, any additional code, such as advertising code, beyond the content of a requested web page itself, that is downloaded along with that page as one complete operation to a client browser will necessarily increase the total download time. If this code is appreciable, then the total download time can significantly lengthen which causes noticeable interstitial delay (latency) to a user stationed at the client, particularly if the client is connected through a rather limited bandwidth connection, e.g., a dial-up network connection, to a server. Noticeable latency often occurs with web pages having conventional non-interstitial embedded advertisements such as banners, animation and other advertising graphics, particularly if the file sizes for those embedded objects are relatively large. As the user latency increases, obviously user aggravation and objections increase concomitantly. The more such advertisements are embedded into the page and particularly if they carry rich content (e.g., audio or video) which necessitate relatively large file sizes, the longer and more noticeable and hence objectionable the latency will be. It is just that simple. See, e.g., page 8, line 5-24 of the present specification.

The Applicants solve this problem by embedding a single tag, i.e., their advertising code, within a referring

web page. Browser execution of that tag incurs negligible processing time and certainly is not noticeable to the user. Once this tag is executed, the browser issues a request to a server which, in turn, downloads the agent. Once the agent is executing under the browser, the agent then controls download and rendering of the information object. The object, in sharp contrast to the teachings of the Himmel et al patent, is not downloaded along with the web page itself.

Given the divergent approach taught by the Himmel et al patent relative to that of the present Applicants, the invention recited in independent claim 2, and companion independent claim 18, is clearly not obvious in view of that patent.

Dependent claims 10-12 and 26-28 recite further distinction features of the present invention over those recited in independent claims 2 and 18, respectively. Hence, none of these dependent claims is rendered obvious over the teachings in the Himmel et al patent for the same exact reasons set forth above with respect to independent claims 2 and 18.

Accordingly, each of these dependent claims is patentable under the provisions of 35 USC § 103.

Objections

The Examiner has objected to claims 5-9, 13-17, 21-25 and 29-33 as being dependent on a rejected base claim. The Examiner stated that all these dependent claims would be

Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
Reply to Office Action of Aug. 12, 2003

allowable if rewritten in independent form to include all the limitations of the base and any intervening claims.

Inasmuch as independent claims 2 and 18, from which these claims 5-9 and 13-17, 21-25 and 29-33 respectively depend, are patentable for the reasons set forth above, the Applicants see no need to re-write these dependent claims into independent form.


Conclusion

Thus, the Applicants submit that none of the claims, presently in the application, is anticipated under the provisions of 35 USC § 102 or obvious under the provisions of 35 USC § 103. Furthermore, the Applicants also submit that all of these claims now fully satisfy the requirements of 35 USC § 112.

Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

Respectfully submitted,

November 12, 2003


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Appl. No. 09/351,857
Amdt. dated Nov. 12, 2003
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